



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,509	10/31/2003	Robert H. Wollenberg	T-6298B (538-61)	3591

7590 11/25/2005

Michael E. Carmen, Esq.
DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

EXAMINER

CHRISTENSEN, RYAN S

ART UNIT PAPER NUMBER

2856

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,509

Applicant(s)

WOLLENBERG ET AL.

Examiner

Ryan Christensen

Art Unit

2858

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 8-12 and 15-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 13 and 14) are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pre-Grant Publication 2002/0147116 (Carrick).

With respect to claim 1, Carrick discloses a plurality of different lubricating oil composition samples comprising a major amount of at least one base oil of lubricating viscosity and a minor amount of at least one lubricating oil additive (Unlabeled Table, Pages 17-19); measuring wear stability of each sample to provide wear stability data for each sample (unlabeled table, pages 17-19 and pg. 17, paragraphs 183 – 197); and, outputting the results (unlabeled table, pages 17-19).

With respect to claim 2, Carrick discloses the limitations of claim 1 wherein the step of measuring wear stability is selected from the group consisting of an extreme pressure wear test hydrodynamic wear test, corrosive wear test and a combination thereof (page 17, paragraphs 183 – 197).

With respect to claim 3, Carrick discloses the step of measuring wear stability further comprises the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being

Art Unit: 2858

selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof (pg.17, paragraph 185).

With respect to claim 4, Carrick discloses the extreme pressure, hydrodynamic and corrosive wear test are conducted simultaneously in accordance with the program control (pg.17, paragraph 185).

With respect to claim 5, Carrick discloses the extreme pressure, hydrodynamic and corrosive wear test are conducted sequentially in accordance with the program control (pg.17, paragraph 185).

With respect to claim 6, Carrick discloses wherein the corrosive wear test is conducted simultaneously with at least one of the extreme pressure and hydrodynamic tests in accordance with the program control (oxidizing agent, pg.17, paragraph 185).

With respect to claim 7, Carrick discloses further comprising the step of systemizing the outputted results of each of the extreme pressure, hydrodynamic and corrosive wear tests, thereby assembling a library of the outputted results associated with each of the plurality of lubricating oil compositions, wherein each one of the wear tests is selected to be indicative of performance of a selected part of or an entire running internal combustion engine (unlabeled table, pages 17-19 and pg. 17, paragraphs 183 – 197).

With respect to claim 13, Carrick discloses at least one lubricating oil additive is selected from the group consisting of antioxidants, anti-wear agents, detergents, rust inhibitors, dehazing agents, demulsifying agents, metal deactivating agents, friction

Art Unit: 2858

modifiers, pour point depressants, antifoaming agents, co-solvents, package compatibilisers, corrosion-inhibitors, ashless dispersants, dyes, extreme pressure agents and mixtures thereof (unlabeled table, pages 17-19).

With respect to claim 14, Carrick discloses further comprising the step of displacing the plurality of lubricating oil compositions to a testing station configured to provide at least one of the extreme pressure wear stability test, hydrodynamic wear test, and the corrosive wear test to determine anti-wear properties of each of the tested lubricating oil compositions in accordance with the program control (paragraphs 183-185).

Allowable Subject Matter

Claims 8-12 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-3,5,13, 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,840, 082 (Evans) discloses an apparatus for high pressure and hydrodynamic testing of oil compositions with automated load control.

U.S. Patent 3,526,127 (Sakis) discloses a method for running a plurality of tests on a large number of oil samples and generating an automated analysis.

U.S. Patent 4,209,414 (Holgado) discloses selectively changing the pressure and duration of a tests run on oil compositions.

U.S. Patent 6,235,691 (Boffa) discloses high load and temperature testing of oil compositions.

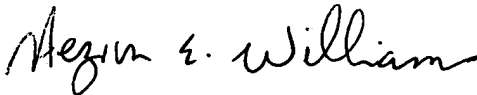
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Christensen whose telephone number is 571-272-2683. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2858

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSC


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800